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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/411,730 10/01/99 KRAMER

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EXAMINER
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MMC2/1012

CARLSON, GASKEY & OLDS  
400 W. MAPLE ROAD, STE. 350  
BIRMINGHAM MI 48009

HAMPDEN, W	
ART UNIT	PAPER NUMBER

2858

DATE MAILED:

10/12/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/411,730

Applicant(s)

KRAMER, DENNIS A.

Examiner

Wasseem H Hamdan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **Part III - DETAILED ACTION**

#### ***Amendment***

1. This office action is in response to applicant's amendment filed on 09/27/2001.
2. The rejection of claims 1-5, 7-8 and 10-18 under 35 U.S.C. 102(e) as being anticipated by Doyle et al. (US Patent number 5,850,188) has been maintained as necessitated by the amendment.
3. The rejection of claims 6, 9 and 16 under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. (US Patent number 5,850,188) in view of Ostermann et al. (US Patent number 5,798,576) or Wallace (US Patent 5,684,337) has been maintained as necessitated by the amendment.
4. Claims 19-21 have been added (Amendment stated that "please add new claims 19 and 20" and the applicant added claims 19-21).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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6. Claims 1-5, 7-8 and 10-18, are rejected under 35 U.S.C. 102(e) as being anticipated by Doyle et al. (US Patent number 5,850,188).

Regarding claims 1, 10 and 15, Doyle et al. disclose a method of actuating electrical components of a vehicle for performing diagnostic analysis on the electrical components [Fig. 1; Fig. 3 (920; column 1: lines 61-66; column 2: lines 60-64; column 5: lines 3-15], said method comprising:

relaying a signal from a remote transmitter [Fig. 1 (18) to a receiver aboard a vehicle [Fig. 1 (12); column 3: lines 46-49];

actuating a plurality of electrical components on the vehicle in response to the signal from the transmitter [Fig. 1; column 2: lines 56-67; column 4: lines 19-30; column 5: lines 9-11].

Visually inspecting the actuation of said plurality of electrical components from the location of said remote transmitter [column 2: lines 56-67].

Regarding claim 2, Doyle et al. disclose including the step of performing diagnostic analysis upon the plurality of electrical components on the vehicle [Fig. 1; column 2: lines 56-60; column 4: lines 33-35] while actuating the electrical components with the remote transmitter [Fig. 1; column 4: lines 19-30; column 5: lines 9-11].

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Regarding claim 3, Doyle et al. disclose wherein said step of relaying a signal from the remote transmitter is further defined by transmitting a radio frequency signal from a remote transmitter to a vehicle receiver [column 3: lines 5-7; column 5: lines 3-15].

Regarding claim 4, Doyle et al. disclose including the step of relaying the signal received by the receiver to an electronic control device located aboard the vehicle [Fig. 1; column 3: lines 46-49].

Regarding claims 5, 10, 17 and 18, Doyle et al. disclose wherein said step of actuating the electrical components is further defined by directing the electronic components [Fig. 1; column 4: lines 47-54; column 4: lines 59-64; Fig. 2]. Doyle et al. disclose the essential elements of the claimed invention. Doyle et al. do not explicitly disclose an actuation cycle programmed into the electronic control device. Doyle et al. disclose that the diagnostic is performed in a programming means [Fig. 2], which inherent and believed that it is done by running the program to cycle through all the components.

Regarding claims 7, 8, 13 and 14, Doyle et al. disclose wherein said step of relaying a signal from the remote transmitter is further defined by transmitting a radio frequency signal [column 3: lines 5-13; column 4: lines 6-18] from a remote transmitter to a keyless entry receiver [FIG. 1; column 2: lines 24-27; column 5: lines 16-22].

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Regarding claim 11, Doyle et al. disclose said step of programming the electronic control device is further defined by entering a temporary program into the electronic control device for actuating the electrical components [Fig. 2].

Regarding claim 12, Doyle et al. disclose wherein said steps of transmitting a signal, and performing diagnostic analysis are executed by a single operator [Fig. 2].

7. Claims 6, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. (US Patent number 5,850,188) in view of Ostermann et al. (US Patent number 5,798,576) or Wallace (US Patent 5,684,337).

Regarding claims 6, 9 and 16, Doyle et al. disclose the essential elements of the claimed invention. However, Doyle et al. do not explicitly disclose of wiring the receiver or wiring the keyless entry receiver to the electrical components for by-passing the electronic control device for directly signaling the electrical components. Ostermann et al. or Wallace disclose of wiring the receiver to the electrical components for by-passing the electronic control device for directly signaling the electrical components [(Ostermann et al. [Fig. 1 (10)]); (or Wallace [Fig. 1 (c)])]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Doyle et al. by including of wiring the receiver or wiring the keyless entry receiver to the electrical components for by-passing the electronic control device

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for directly signaling the electrical components. The skilled artisan would have been motivated to modify Doyle et al. as above for the purpose of performing diagnostics on the vehicle.

Claims 19, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. (US Patent number 5,850,188) in view of Traub (US Patent number 6,265,878 B1).

Regarding claims 19, 20 and 21 Doyle et al. disclose the essential elements of the claimed invention. However, Doyle et al. do not explicitly disclose the testing brakes and at least some lights. Traub disclose testing include brakes and at least some lights [FIG. 1; column 1: lines 7-8]. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the teachings of Doyle et al. by including testing brakes and at least some lights. The skilled artisan would have been motivated to modify Doyle et al. as above for the purpose of performing diagnostics on the brakes and lights of a vehicle.

### ***Response to Amendment***

8. Applicant's arguments filed 09/27/2001 have been fully considered but they are not persuasive. The Amendment is insufficient to overcome the prior art of record.

Applicant's arguments that Doyle et al. do not disclose visual inspection all plurality of electrical components. The examiner respectfully disagrees, because Doyle et al. invention disclose "the transmitter includes transmitting means for transmitting a plurality of signals to the receiver unit...." [column 2: lines 43-47], and disclose "the receiving unit also includes a display

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panel for displaying the diagnostic report.” [column 2: lines 65-67]. The technology is the same, and it does not matter if the technology is applied to a key fob or something else, it is still the same technology but different application. The Examiner invites the applicant to take a look at following court case.

Apparatus is: “What it is, not what it does”

It should be emphasized that “apparatus claims must be structurally distinguishable from the prior art.” MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of **structure** rather than **function**. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: “Apparatus claims cover what a device **is**, not what it **does**.” (emphases in original). To emphasize the point further, the court added: “An invention need not **operate** differently than the prior art to be patentable, but need only **be** different” (emphases in original).

That is, in an apparatus claim, if a prior art structure discloses all of the **structural elements** in the claim, as well as their relative juxtaposition, then it **reads** on the claim, regardless of whether or not the **function** for which the prior art structure was intended is the same as that of the claimed invention.



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***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached Monday-Thursday from 700AM-400PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Safet Metjahic can be reached on (703) 308-1436.

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The fax phone number for this Art Unit are (703)308- 7722, (703)308- 7724, (703)305-3432 or (703)305-3431.

Any inquiry of a general nature or relating to the status of this application should be directed to the Receptionist at (703) 308-0956.

**11. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703)308- 7722, (703)308- 7724, (703)305-3432 or (703)305-3431.

(for formal communications intended for entry, please label "FORMAL" and sign as attorney of record, for informal or draft communications, please label "PROPOSED" or "DRAFT" and prominently label PLEASE DELIVER DIRECTLY TO EXAMINER).

Hand-delivered responses should be brought to Crystal Plaza 4 [fourth Floor (Receptionist)], 2201 South Clark Place, Arlington, VA. 22202.

Wasseem H. Hamdan

*WH*

October 9, 2001

*Glenn W. Brown*  
Glenn W. Brown  
Primary Examiner